

### REMARKS

This response is submitted in response to the Final Office Action mailed October 19, 2004 to request reconsideration of the rejection of claims 1-9 and 11-13 as set forth therein.

Initially, the Applicants would like to thank the Examiner for the indication that claim 10 contains allowable subject matter.

In the Official Action, the Examiner has withdrawn the previous grounds of rejection under 35 U.S.C. § 102(b) in favor of rejections under 35 U.S.C. § 103(a). Specifically, the Examiner rejects claims 1-5, 9, and 11-13 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,616,876 to Cluts (hereinafter "Cluts") in view of U.S. Patent No. 5,969,283 to Looney et al., (hereinafter "Looney"). Additionally, the Examiner rejects claims 6-8 under 35 U.S.C. § 103(a) as being unpatentable over Cluts and Looney and further in view of U.S. Patent Application No. 2003/0229537 to Dunning et al., (hereinafter "Dunning").

In response, Applicants respectfully traverse the Examiner's rejections under 35 U.S.C. § 103(a) for at least the reasons set forth below.

In response to the previous Official Action, Applicants argued that Cluts fails to teach randomly selecting an information unit for presentation to a user. The claims were also amended to clarify such a distinction. In response, the Examiner has combined Cluts with Looney to "address this new limitation" (see page 11, lines 6-8 of the Final Official Action). In this regard, the Examiner argues that "It would have been obvious to one of ordinary skill in the art at the time of the invention to include a randomization function as claimed, since such functionality is desirable to prevent the monotony of being presented the

same songs in the same order, and further because such functionality has been well known and common in the art for many years, such as randomize function CD players." (see page 5, lines 9-13 of the Final Official Action).

Applicants disagree with the Examiner's suggestion and motivation for the combination of the Cluts and Looney references and respectfully submit that such combination is improper and must be withdrawn for at least the reasons set forth below.

The U.S. Court of Appeals for the Federal Circuit (the "Federal Circuit") has consistently and repeatedly stated the legal test applicable to rejections under 35 U.S.C. § 103(a). Recently (*In re Rouffet*, 47 USPQ2d 1453 (Fed. Cir., July 15, 1998)), the Court stated:

[V]irtually all [inventions] are combinations of old elements. Therefore an Examiner may often find every element of a claimed invention in the prior art. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an Examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." To prevent the use of hind sight based on the invention to defeat patentability of the invention, this court requires the Examiner to show a motivation to combine the references that create the case of obviousness. The Board [of Appeals] did not, however, explain what specific understanding or technological principle within the knowledge of one of ordinary skill in the art would have suggested the combination. Instead, the Board merely invoked the high level of skill in the field of the art. If such a rote indication could suffice to supply a motivation to combine, the more sophisticated scientific fields would rarely, if ever, experience a patentable technical advance. Instead, in complex scientific fields, the Board could routinely identify the prior art elements in an application, invoke the lofty level of skill, and rest its case for rejection. To counter this potential weakness in the obviousness construct **the suggestion to combine requirements stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness.**

*In re Rouffet*, 47 USPQ2d 1457-58 (Fed. Cir., July 15, 1998) (citations omitted, emphasis added).

More recently, the Federal Circuit again dealt with what is required to show a motivation to combine references under 35 U.S.C. § 103(a). In this case the court reversed the decision of the Board of appeals stating:

[R]ather than pointing to specific information in Holiday or Shapiro that suggest the combination..., the Board instead described in detail the similarities between the Holiday and Shapiro references and the claimed invention, noting that one reference or the other-in combination with each other... described all of the limitations of the pending claims. Nowhere does the Board particularly identify any suggestion, teaching, or motivation to combine the ... references, nor does the Board make specific-or even inferential-findings concerning the identification of the relevant art, the level of ordinary skill in the art, the nature of the problem to be solved, or any factual findings that might serve to support a proper obviousness analysis.

*In re Dembiczak*, 50 USPQ2d 1614, 1618 (Fed. Cir., April 28, 1999) (citations omitted).

Thus, from both *In re Rouffet* and *In re Dembiczak* it is clear that the Federal Circuit requires a specific identification of a suggestion, motivation, or teaching why one of ordinary skill in the art would have been motivated to select the references and combine them. This the Examiner has not done. The Examiner includes two reasons for the suggestion and motivation to combine the Cluts device with the randomization disclosed in Looney.

(1) such functionality (randomization) is desirable to prevent the monotony of being presented the same songs in the same order; and

(2) such functionality has been well known and common in the art for many years, such as randomize function CD players.

*In re Rouffet* and *In re Dembiczak* make it clear that this alone is not enough.

In fact, the facts of *In re Dembiczak* are analogous to the facts of the present invention. In this case, the patentee claimed a decorative plastic trash or leaf bag which is

orange in color and has facial indicia on it such that when filled and closed it takes the form of a pumpkin with a face thereon. Among the cited references made by the patent office were:

- Handbook which taught school teachers how to make crepe paper jack-o-lanterns and a paper bag pumpkin by stuffing a bag with newspapers, painting it orange, and painting facial features on it with black paint; and
- Conventional trash bags.

The Board of Appeals affirmed the Examiner's Final Rejection holding that the claims are obvious in light of the conventional trash bags in view of the handbook references. To justify this rejection the Board stated that "the [handbook references] would have suggested the application of ... facial indicia to the prior art plastic trash bags." The Federal Circuit pointed out that rather than pointing to specific information in the handbook references that suggest the combination with the conventional trash bags, the Board instead described in detail the similarities between the handbook references and the claimed invention, noting that one reference or the other, in combination with each other and the conventional trash bags, describe all of the limitations in the pending claims (*See, In re Dembiczak* at page 1618).

The Board failed to show how this reference-by-reference and limitation-by-limitation analysis demonstrated how the handbook references teach or suggest their combination with the conventional trash bags to yield the claimed invention (*Id.*). The Board did not identify any teaching, suggestion, or motivation to combine the handbook references with the conventional trash bags, nor did it make specific, or even inferential- findings concerning the identification of the relevant art, the level of ordinary skill in the art, the nature

of the problem to be solved, or any other factual findings that might serve to support a proper obviousness analysis (*Id.*).

Similarly, in the present application the Examiner combines a reference teaching a system for selecting music on the basis of subjective content with a reference teaching a conventional randomization to defeat the patentability of the claimed invention without identifying how one of the references teaches or suggests that it be combined with the other. Furthermore, where a feature is not shown or suggested in the prior art references themselves, the Federal Circuit has held that the skill in the art will rarely suffice to show the missing feature. *Al-Site Corp. v. VSI International Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999) (Rarely, however, will the skill in the art component operate to supply missing knowledge or prior art to reach an obviousness judgment).

Additionally, with regard to item (1) above, the Examiner argues that such functionality (randomization) is desirable to prevent the monotony of being presented the same songs in the same order. Although such is most likely the object of a conventional randomization, such as in Looney, the same is not an objective of the present invention. As stated on page 1, lines 25-27 of the present application, the objective of the present invention is to provide a system and method which enables a user to easily explore the collection of information units by providing a system comprising a random selection means for randomly selecting a unit for presentation whose attribute value meets a criterion. Such a combination is nowhere disclosed or suggested in Cluts or Looney. Therefore, those skilled in the art would not be motivated or suggested to look to either Cluts or Looney to solve the objective addressed by the present invention.

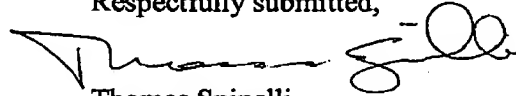
Furthermore, with regard to item (2) above, the Examiner argues that the randomization functionality has been well known and common in the art for many years, such as randomize function CD players. Applicants respectfully submit that such a factor is irrelevant in an obviousness analysis. The only test to be applied when considering obviousness is whether there is a motivation or suggestion to combine the references. As discussed above, the Examiner has not made such a showing, either in the references themselves or in the art in general.

Thus, Applicants respectfully submit that the Examiner, without identifying a suggestion, motivation, or teaching for combining the references, has used impermissible hindsight in rejecting the claims under 35 U.S.C. § 103(a). As discussed above, the Federal Circuit in *In re Rouffet* stated that virtually all inventions are combinations of old elements. Therefore an Examiner may often find every element of a claimed invention in the prior art. To prevent the use of hindsight based on the invention to defeat patentability of the invention, the Examiner is required to show a motivation to combine the references that create the case of obviousness. Applicants respectfully submit that the Examiner has not met this burden.

In light of the state of the law as set forth by the Federal Circuit and the Examiner's lack of specificity with regard to the motivation to combine the cited references, the applicant respectfully submits that the rejections for obviousness under 35 U.S.C. § 103(a) lack the requisite motivation and must be withdrawn.

The above amendments and remarks establish the patentable nature of all the claims currently in this case. Issuance of a Notice of Allowance and passage to issue of these claims are therefore respectfully solicited. If the Examiner believes that a telephone conference with Applicant's attorney would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,



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